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March 15, 2007

VIA FACSIMILE

To: Supervisory Examiner Charles Rones
Group Art Unit No. 1756
U.S.P.T.O.

Facsimile No.: (571) 273-8300

From: Scott M. Tulino

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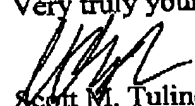
Re: Attached Petition to Enter Declaration under 37 C.F.R. §1.181
U.S. Patent Application Serial No. 10/733,380
Our Reference: MAS.018

Dear Supervisory Examiner Rones:

Attached is a Petition to Enter Declaration under 37 C.F.R. §1.181, which we request that you enter and which should place the application in condition for allowance.

Thank you in advance for your consideration on this case.

Very truly yours,


Scott M. Tulino
Sean M. McGinn

SMT/SMM/emh
Attachment

Total No. of Pages Transmitted: 7(including this cover sheet)

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Docket No. FJ-2003-046-US
(MAS.018)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Koki Okamura

Serial No.: 10/733,380

Group Art Unit: 2164

Filed: December 12, 2003

Examiner: Sathyanaraya R. Pannala

For: FILE TRANSFER PROGRAM

Honorable Commissioner of Patents
Alexandria, VA 22313-1450

PETITION TO ENTER DECLARATION UNDER 37 C.F.R. §1.181

Sir:

Applicant respectfully petitions under 37 C.F.R. §1.181 that the Examiner enter the Declaration Under 37 C.F.R. § 1.131 filed on November 14, 2006.

The Examiner has erroneously maintained that the "declaration filed on 9/5/2006 under 37 CFR 1.131 has been considered but is ineffective to overcome the Allam (USPA Pub. 2004/0139400) reference because of the following reasons:

- The proposed reply filed on 9/5/2006 has not been entered because it is unsigned.
- The declaration does not contain the invention disclosure statement correlating to the claims.
- The declaration does not contain explanation of the contents of the invention disclosure document."

1) First, Applicant has repeatedly point out to the Examiner that the Amendment filed on September 5, 2006 specifically noted that the un-executed declaration under 37 C.F.R. § 1.131 was being filed to expedite the Examiner's consideration of the application, and that the executed declaration would be filed upon receipt from the inventor (see Amendment under 37 C.F.R. § 1.111 filed on September 5, 2006, at page 11, lines 4-8).

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Accordingly, the executed Declaration under 37 C.F.R. § 1.131 was filed in the USPTO via facsimile on November 14, 2006, as evidenced on the USPTO PAIR site.

As indicated on the PAIR site, Applicant has repeatedly pointed out to the Examiner that the present Office Action was entered on November 24, 2006, and mailed on November 27, 2006, which was after the filing of the executed Declaration under 37 C.F.R. § 1.131 on November 14, 2006.

Thus, the Examiner properly should have entered and considered the executed Declaration, which was filed on November 14, 2006, prior to issuing the Final Office Action.

Indeed, since the un-executed Declaration and the executed Declaration were identical, except for the inventors' signatures, sufficient time clearly was available to enter and consider the executed Declaration prior to entering the Office Action on November 24, 2006, and subsequently mailing the same on November 27, 2006.

It was noted that the Examiner has considered the content of the unexecuted Declaration, although the subsequently filed executed Declaration was not entered.

2) Second, with respect to the Examiner's allegation that the "declaration does not contain the invention disclosure statement correlating to the claims," it has been repeatedly pointed out to the Examiner that the Declaration under 37 C.F.R. § 1.131 clearly includes a statement that the inventor is the sole inventor of the above-identified application (see Declaration under 37 C.F.R. § 1.131, at numbered paragraph (1)). Clearly, since Applicant is the sole inventor of the present application, the Applicant is the sole inventor of all of the claims of the present application.

Moreover, Applicant has pointed out that paragraph 5 of the Declaration clearly states that:

5) The contents of the enclosed "Invention Disclosure Documents" (Exhibit 1) have been incorporated into the specification of the present invention, upon which claims 1-14 are based.

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Moreover, Applicant submits that all of the requirements for filing a Declaration under 37 C.F.R. § 1.131 have been met by the present Declaration (e.g., see 37 C.F.R. § 1.131; see also 37 C.F.R. § 1.68; see also M.P.E.P. § 715).

It is noted that 37 C.F.R. § 1.131 states that:

(a) When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based. The effective date of a U.S. patent, U.S. patent application publication, or international application publication under PCT Article 21(2) is the earlier of its publication date or date that it is effective as a reference under 35 U.S.C. 102(c).

(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained.

That is, Applicant must show invention of the subject matter of the rejected claims. In this case, the Exhibits submitted with the Declaration show invention of the subject matter of the rejected claims.

Applicant is not aware of a requirement that an invention disclosure statement that explicitly identifies the rejected claims must be made for the Declaration under 37 C.F.R. § 1.131 to be effective. Furthermore, Applicant has repeatedly requested the Examiner to provide support for this alleged requirement. The Examiner, however, has indicated that he does not where the M.P.E.P. lists such a requirement (e.g., Examiner's statement provided during a personal interview conducted on March 7, 2007).

During the personal interview conducted on March 7, 2007, the Examiner erroneously alleged that Applicant is required to "map" to claims to the exhibits submitted with the

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Declaration. Applicant submits, however, that the M.P.E.P. does not include such a requirement. Furthermore, after repeated requests to the Examiner, the Examiner has failed to provide any support for this alleged requirement.

3) Third, in response to the Examiner's allegation that the "declaration does not contain explanation of the contents of the invention disclosure document," Applicant has repeatedly noted that a full English language translation of the Invention Disclosure Document was submitted as Exhibit 2, together with the Declaration.

Thus, it is unclear what explanation of the contents of the invention disclosure document that the Examiner considers to be missing from the Declaration.

In the interview, Applicant's representative again requested that, should the Examiner consider this statement to be a requirement of a Declaration under 37 C.F.R. § 1.131, the Examiner identify the basis for this requirement in the applicable law, rules, or procedures. The Examiner, however, has indicated that he does not where the M.P.E.P. lists such a requirement (e.g., Examiner's statement provided during a personal interview conducted on March 7, 2007).

For the foregoing reasons, Applicant submits that the Declaration under 37 C.F.R. § 1.131 filed on November 14, 2006 properly should have been entered by the Examiner.

Moreover, Applicant submits that the Allam reference should be removed as prior art, since Applicant has perfected the claim to foreign priority and properly filed a Declaration under 37 C.F.R. § 1.131 showing invention of the subject matter of the present application prior to the effective filing date of the Allam reference.

Applicant points out that the § 102(e) date of October 23, 2002 of Allam is one (1) month and twenty (20) days prior to the filing date of the present application's Japanese priority document on December 13, 2002.

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Therefore, Allam should be removed as prior art under 35 U.S.C. § 102(e) because Applicant (1) perfected the claim to foreign priority based on JP 2002-361998, which was filed on December 13, 2002, by the filing a verified English translation thereof on September 5, 2006; and (2) filed the executed Declaration under 37 C.F.R. § 1.131 which properly swears behind the critical date (i.e., October 23, 2002) of Allam, by establishing invention of the subject matter of the present application before the Allam reference's effective § 102(e) prior art date of October 23, 2002.

Applicant submits that the Declaration properly swears behind the effective prior art date of the Allam reference by establishing a reduction to practice prior to the effective date of the Allam reference, or in the alternative, conception of the invention, coupled with due diligence from just before the effective date of the Allam reference up to the constructive reduction to practice of the present application by the filing of the JP 2002-361998 priority document.

Accordingly, Applicant petitions for the Examiner to enter and consider the executed Declaration filed on November 14, 2006 and to remove the Allam reference.

Respectfully Submitted,

Date: March 15, 2007



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FACSIMILE TRANSMISSION

I hereby certify that I am filing this paper via facsimile, to Group Art Unit 2164, at (571) 273-8300, on March 15, 2007.

Date: March 15, 2007

Respectfully Submitted,



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